

Application No. 10/076,976

REMARKS

Claims 18-30 are pending. An Advisory Action of April 26, 2004 indicated the previous issue under 35 U.S.C. § 112, first paragraph had been overcome by the Amendment After Final of March 12, 2004. Based on this, the Examiner extended the anticipation rejection to claims 18-21, 23-28 and 30. However, the Examiner has raised new issues under 35 U.S.C. § 112, first paragraph based on the claim amendments in the March 12, 2004 Amendment. Therefore, the Examiner did not comment in the Advisory Action on Applicants' arguments over the anticipation rejection. To advance prosecution Applicants address the new matter issue here.

Also, Applicants respectfully assert that prosecution would advance more quickly if the Examiner considers all of the pending issues rather than requiring a resolution of the 112 issues prior to considering the art issues. This consideration of all the pending issues is mandated by MPEP 707.07(g) Piecemeal Examination.

Rejection Under 35 U.S.C. 112, First Paragraph

In the Advisory Action of April 26, 2004, the Examiner indicated that Applicants' amendment of claim 18 raised new matter issues. Specifically, the Examiner indicated that the originally filed specification did not support the expression "weakly agglomerated." With all due respect, Applicants maintain that this expression is well supported by the specification. Applicants assert that the Examiner has failed to establish a prima facie showing of a lack of written description. Applicants respectfully request reconsideration of the rejection based on the following comments.

An amendment to a claim that raises a potential new matter issue should be analyzed under the framework of the Written Description requirement under section 112, first paragraph. See MPEP 706.03(o). It is well established that an amendment to a claim does not need literal support with identical language in the specification to avoid a written description

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rejection. See MPEP 2163, I.B. New or Amended Claims. The issue is whether or not a person of ordinary skill in the art would recognize from the application as filed that the inventors had possession of the claimed invention as a whole. See MPEP 2163 II.3.

Applicants explicitly pointed, as an example, to the specification at page 18, lines 1-4 for support of the claim amendment. See Amendment After Final at page 4. Specifically, the specification states that "Because of their small size, the primary particles tend to form loose agglomerates due to van der Waals and other electromagnetic forces between nearby particles." The Examiner has not explained how this statement does not support the specific language of the claim.

With respect to the meaning of the "weak agglomerates" expression in the claim, such an expression implies to a person of ordinary skill in the art that the particles can be dispersed, i.e. separated from each other. In contrast, hard fused particles cannot be separated. The high dispersability of these titania particles formed by laser pyrolysis is described further in U.S. Patent 6,599,631 to Kambe et al., entitled Polymer-Inorganic Particle Composites, Example 2. Applicants maintain that the meaning of the expression is clear to a person of ordinary skill in the art as distinguishing hard fused particles.

In view of the above comments, Applicants respectfully request withdrawal of the rejection of claim 18 under 35 U.S.C. § 112, first paragraph for lack of written description.

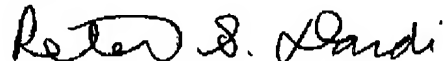
CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

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The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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